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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/776,311

02/02/2001

Naofumi Ueda

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21874

7590

09/13/2004

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EXAMINER

PENDERGRASS, KYLE M

ART UNIT

PAPER NUMBER

2624

DATE MAILED: 09/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/776,311

Applicant(s)

UEDA, NAOFUMI

Examiner

Kyle M Pendergrass

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

Claims 1-18, & 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Apparatus claims 1 (line 5), 2-14, 18 (line 3) & 24 (line 4) are vague and indefinite because they recite a function for, but fail to particularly point out and distinctly claim, a structural element or means to implement the function of claims 1, 18, & 24 of the preliminary amendment.

Method claims 15, 16 & 17 are vague and indefinite because the claims present a whereby clause which recites a use without particularly pointing out or distinctly claiming any active or positive steps that describe how this use is practiced or implemented.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Ueda et al. (US 5,956,471).**

Regarding claims 1, 2, 18, 19 & 24, which reflect claims 15 & 16, Ueda et al., (US 5,956,471) discloses a printing apparatus (column 8, lines 38-39) comprising a function by which a print job to which a password is attached (Fig 11, step 22) and which is transmitted from said host device (column 8, lines 41-42) and printed when a password is entered (Fig 11, step 30) from an input unit (key panel 411, column 8 lines 56-58). Ueda et al., discloses holding the print job to which a password is attached together with normal print jobs for which no password entry is required in a queue that manages the order of all print jobs and a control unit 104 for sequentially carrying out the printing of the print jobs in order of entry (column 7, lines 37-47), giving preference to the password-attached print job over the normal print jobs, which require no password entry, that are waiting for print (Fig 11 steps 29-30 send the secret document, upon password verification, to the printer and ahead of the normal printouts). It is inherent that the print queues are in order by preference and that the preference is in order of receipt.

Regarding claims 3 & 4, Ueda et al., disclose the printing apparatus according to claims 1 & 2. Ueda et al., further disclose a main control part comprising a CPU (column 5, line 17) that controls the start of printing (column 5, line 23). The clocking of print jobs is met by the clocking of the CPU in the Ueda et al., disclosure, which has a timing means built in to control the output of the print jobs.

Regarding claims 5-7 & 9-14, Ueda et al., disclose the printing apparatus according to claim 1 wherein the sequencing of print jobs is accomplished by a control means that controls the transfer order of the produced data so that the data is

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subsequently received and preferentially output (column 7 lines 37-47). Once a password is inputted that job is printed immediately (Fig 11, steps 29-30). Ueda et al., do not disclose a control unit that comprises two pointers, one for indicating the end of password-attached print jobs stored in the queue, and one for indicating the end of the normal print jobs stored in the queue. The Office interprets that the pointers in the invention are equivalent to the ordering ability of Ueda et al., that allows preferential ordering of print queue documents.

Regarding claims 8, 20, & 21, which reflect claims 17 & 22, Ueda et al., disclose the apparatus in claim 1 & 19. Ueda et al., further disclose an image list for displaying documents sorted by queue arrival (Fig 10, display panel 410), and a designation option where one print job on the list can be selected (Fig 10, key panel 411, column 8, lines 55-58)

Regarding claim 23, Ueda et al., disclose the apparatus of claim 22. Ueda et al., further disclose a displayed notice in the event that the password for the password-attached print job does not agree with the password entered via the input unit (column 8, lines 41-44, 56-57, 62-63, 67; column 9, lines 1-12; column 7, lines 15-17).

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle Pendergrass whose telephone number is (703) 306-3445. The examiner can normally be reached on Monday-Friday 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiners supervisor, David K. Moore can be reached on (703) 308-7452. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application of proceeding should be directed to the receptionist whose telephone number is (703) 305-9700.

A handwritten signature in black ink, appearing to read "David K. Moore", with a stylized flourish at the end.

DAVID MOORE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600